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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,708	07/14/2003	Frank Beerwerth	056427-5004-01	4185

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EXAMINER


VERBITSKY, GAIL KAPLAN

ART UNIT PAPER NUMBER

2859

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	<b>Application No.</b> 10/617,708	<b>Applicant(s)</b> BEERWERTH ET AL.	
	<b>Examiner</b> Gail Verbitsky	<b>Art Unit</b> 2859	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 9-19 is/are rejected.
- 7) ☒ Claim(s) 7 and 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)<br>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)<br>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____<br>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)<br>6) <input type="checkbox"/> Other: ____ |
|--|--|

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 3, 4, 6-7, 10-12, 18 are objected to because of the following informalities:

Claim 3: "o" in line 2 should be replaced with --of--,

Claim 4: "the air chamber(s) (are)..." should be replaced with --the several air chambers are--for a proper antecedent basis and in order to clearly describe the invention.

Claim 5: "the air chamber(s) has (have) its (their) outside(s)" should be replaced with --the several air chambers have their outsides--for a proper antecedent basis and in order to clearly describe the invention.

Claim 6: "the air chamber(s) has (have) its (their) outside(s)" should be replaced with --the several air chambers have their outsides--for a proper antecedent basis and in order to clearly describe the invention.

Claim 7: "the air chamber(s) is (are)" should be replaced with --the air chambers are--for a proper antecedent basis and in order to clearly describe the invention.

Claim 12: "the tubular member" in line 2 lacks antecedent basis.

Claim 18: "the forming operation" in lines 1-2 lacks antecedent basis.

Claims 10-12: the numeral 26 is referred to three different structures: holding device, annular body and clamping device.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6, 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In this case,

Claims 6, 14-15: "preferably" makes the claim language confusing because it is not clear if the limitation prior to "preferably" is being claimed.

Claim 16: A) the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

B) "particular" makes the claim language confusing because it is not clear if the limitation prior to "particularly" is being claimed.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-6, 9, 14-17, 19 are rejected under 35 U.S.C. 102(a) as being anticipated by Cheslock et al. (U.S. 6042266) [hereinafter Cheslock].

Cheslock discloses in Figs. 3-4 a protective cap 50 for a temperature-measuring probe of infrared radiation (tympanic) thermometer introducible in an ear cavity. The cap comprises additional structures: a closed cell polyolefin, polypropylene, polystyrene, or polyurethane foam (porous material) that allow the probe cover to deform when inserted into a patient ear sealing the ear, the foam, along with other purposes, serves as an

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excellent heat insulator (col. 6, line 38). Cheslock also discloses a lamination layer (base body) of polyethylene (plastic) closing the foam. The cap is covered with a transparent layer/ window 70 stretched over the base body. Both, the base body and the foam are shaped to conform the ear cavity.

For claim 3: the pores are air filed chambers.

For claim 4: the lamination layer closes the pores/ chambers.

For claim 5: the outside of the air chambers is close to the body cavity and bounded by the lamination layer/ flexible film.

For claim 16: as shown in Fig. 3, the cap is fitted onto the probe, but not shaped to the body cavity yet. The cap conforms the body cavity (being shaped/ deforms) only when it is inserted into the body cavity. Therefore, the cap can expand/ stretch to obtain the necessary shape only when it is inserted into the body cavity, and thus, not prior to being positioned onto the probe.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheslock in view of Lin (U.S.5906437).

Cheslock discloses the device as stated above in paragraph 5.

Cheslock does not explicitly teach that the window film is stretched by means of a holding device.

Lin discloses in Figs. 5, 8 a device wherein a window film 83 is held by means of an annular holding device A which is clamped to a tubular body B (the numerals A-B have been added by the Examiner, see attachment to the Office action).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a holding device, as taught by Lin, to the device disclosed by Cheslock, so as to provide a better stretch of the transparent window, in order to eliminate wrinkles, and thus, to provide more accuracy in measurements.

8. Claim 13, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheslock in view of Bohrn et al. (U.S. 4775586) [hereinafter Bohrn].

Cheslock discloses the device as stated above in paragraph 5.

Cheslock does not teach a hot pressing or hot stamping operation to make the cap, as stated in claims 13, 18.

Bohrn teaches that using a method of hot pressing for a film, a desired transparency to an electromagnetic radiation (including IR) can be obtained.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a method of hot pressing, to provide a transparent window of the device disclosed by Cheslock, with a desired transparency, i.e., to IR, as taught by Bohrn, because this method is commonly used to obtain a desired transparency in plastic films.

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***Allowable Subject Matter***

9. Claims 7-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in the PTO-892 and not mentioned above disclose related devices and methods.

Any inquiry concerning this communication should be directed to the Examiner Verbitsky who can be reached at (571) 272-2253 Monday through Friday 8:00 to 4:00 ET.

GKV

Gail Verbitsky

Primary Patent Examiner, TC 2800



March 01, 2004